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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,069	05/26/2005	Stephanie Wald	U 015600-5	7590

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EXAMINER	
LE, KHANH H	

ART UNIT	PAPER NUMBER
3688	

NOTIFICATION DATE	DELIVERY MODE
10/19/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

nyuspatactions@ladas.com

Office Action Summary	Application No.	Applicant(s)	
	10/522,069	WALD ET AL.	
	Examiner	Art Unit	
	KHANH H. LE	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04/27/2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23,67-84,92,95-97,99-101,106-108 and 110* is/are pending in the application.

4a) Of the above claim(s) *See Continuation Sheet* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23,72-84,92,95-97,99-101,106-108 and 110* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *67-71* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *See Continuation Sheet*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims further withdrawn from consideration are 67-71 as part of Group II. See Office Action for further details.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :2005-04-14 ; 2005-07-18; 2009-08-18;2009-09-22 .

DETAILED ACTION

1. This Office Action is responsive to the correspondence filed 04/27/2009. In Response to the Office Action of 2 April 2009, **Applicant elected Group I, claim(s) 1-23,67-84, 92, 95-97, 99-101, 106, 107, 108, and 110.** Claims 24 - 66, 85 - 81, 93, 94, 98, 102 - 105, 109, 111, 112, corresponding to groups II and III, have been cancelled.

Restriction Requirement under 35 U.S.C. 121 and 372

2. In the Office Action mailed April 02, 2009 the Examiner had indicated the following Groups for restriction.

Group I, claim(s) 1-23,67-84, 92, 95-97, 99-101, 106, 107, 108, and 110 drawn to an advertising control method for receiving an advertisement identification message (AIM) at a first mobile device; sending the AIM from the first mobile device to a content display unit (CDU) and storing the AIM in the CDU; selecting at least one content item from among a plurality of content items based, at least in part, on at least one stored AIM, the stored AIM being stored in the CDU; and displaying the selected content item on the CDU.

Group II, claim(s) 24-66, 93, 94, 102-104, 105, and 111 drawn to content control method and means or apparatuses for associating an entitlement with a content item identifier; embedding the entitlement in an article; sending the entitlement from the article to a content display unit (CDU); and displaying a content item associated with the content item identifier on the CDU.

Group III, claim(s) 85-88, 89-91, 98, 109,112 drawn to a content item selection method comprising and apparatuses for: accumulating content item display points for each of a plurality of display point categories; and choosing a content item for display based, at least in part, on a comparison between a point total for one of the display point categories and a category associated with the content item.

Upon further consideration it appears that claims 67-71 are directed to the same subject matter as Group II and should have been included therein. Thus a correction is herein made:

Group I includes claim(s) 1-23,72-84, 92, 95-97, 99-101, 106, 107, 108, and 110.

Group II includes claim(s) 24-66, 67-71, 93, 94, 102-104, 105, and 111.

Group III remains the same.

The Groups are directed to the inventions set forth above (the same as stated in the Office Action mailed April 02, 2009).

During a telephone conversation with Mr. Clifford Mass on 9/30/09, Mr. Mass agreed to further withdraw claims 67-71 as part of Group II. Thus a provisional election was made without traverse to prosecute the invention of Group I, claim(s) 1-23, 72-84, 92, 95-97, 99-101, 106, 107, 108, and 110.

Affirmation of this election must be made by applicant in replying to this Office action.

Thus presently claims 67-71 are further withdrawn from further consideration by the examiner, per 37 CFR 1.142(b), as being drawn to Group II, a non-elected invention.

Thus Group I, **claim(s) 1-23, 72-84, 92, 95-97, 99-101, 106, 107, 108, and 110 are presently pending and herein examined.**

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 78-84 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 78-84: mix statutory classes (apparatus and method) thus claim scope is unclear. E.g. claim 78: a CDU is directed to apparatus, then "is delivered" is directed to a method. Correction is needed.

5. Claim interpretation:

Claims 106 -108:

Applicant appears invokes 35 USC §112-6th paragraph by (1) utilizing the phrase "means for", (2) modified by functional language, (3) without an indication of sufficient structure, materials, or acts, in the claim, to achieve those functions. In this vein, Claims **106 - 108** would ordinarily be construed to cover the corresponding structure, material or acts

disclosed in the specification and equivalents thereof.

Since claims 106 -108 parallel claims 72, 73, 77, it is interpreted the associated structures are the same as those recited in claims 72, 73, 77 i.e. AIM receiver, AIM storage unit, AIM dispenser, AIM sender, content item selector.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

7.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-4, 10, 72-84, 92, 95-97, 106, 107, 108, and 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ota et al., US 2002/0035545, Antonucci US 2003/0236704, and the admitted art.

Claims 1-4, 10, 72-84, 92, 95-97, 106, 107, 108, and 110:

Ota discloses selling points (i.e. AIMs) to wireless mobile devices; sending points to a central server to accumulate per user accounts; users can log on the internet to download digital content when redeeming points with central server; transfer of points via secure links; points encryption and decryption [0021], [0051]; [0082]; claim 12; description key, [0049].

Thus Ota discloses:

An advertising control method comprising: receiving a point (i.e. an advertisement identification message (AIM)) at a first mobile device; selecting at least one content item from among a plurality of content items based, at least in part, on at least one stored AIM, the stored AIM being stored in the network server ; and displaying the selected content item.

Ota does not disclose sending the AIM from the first mobile device to a content display unit (CDU) and storing the AIM in the CDU.

However, Antonucci discloses multiple merchant stored value card where the points can be stored locally on a user device from a smart card, a PDA, to a laptop or other portable processor of information. Antonucci discloses any combination of device of remote accessibility or local access is contemplated ([0020], [0027], [0032]). **In such embodiments processing functions, memory, databases are stored locally on the user device [0020]. The object is to make remote access not necessary ([0020]).** User device can download from and transmit its data to any other device [0057] including audio rf, optical based devices etc… ;all electronic points of interaction are contemplated such as PDA's cell phones, kiosks ([0032]); any combination of databases is contemplated ([0032]); encryption and decryption of data is contemplated ([0032]); consumer devices to interact with the loyalty system including redeeming the loyalty points include all devices such as kiosks, PDA's , cell phones, and the like ([0038]) . Antonucci also discloses consumer and family accounts [0057]; in Antonucci, each merchant points read on a kind of points or AIMS.

It would have been obvious to one having ordinary skill in the art at the time of the invention (herein a "PHOSITA") to replace Ota's accessing the central server to redeem the points with accessing the points from local storage, to make remote access not necessary (Antonucci, [0020]). In that case, the points obviously would have to be stored locally at a local device as taught by Antonucci. **Thus it would have been obvious for the Ota user to transfer the points to a local device for storage rather than at the server.**

Further it is admitted ubiquitous computing (i.e. everyday appliances endowed with computing power to deal with information-based tasks) is well-known (Specifications, herein, "Sp.,", [0005]). The following technologies are also admitted as well-known: Bluetooth, wifi (Sp.,[0006]); detection of devices, such as polling, by wireless protocols (Sp., [0183]); wireless protocol dictates how proximate the devices can be (Sp., [0214]); digital id's (Sp., [0004]); ad payload can be video audio interactive other data etc.. (Sp.,[0254]).

Since Ota teaches redeeming the points for digital content, since Antonucci discloses any user device can communicate loyalty points to any other ([0057]) and since ubiquitous computing is admittedly well-known, it would have been obvious to a PHOSITA to use one of the everyday appliances e.g. a home television to display the redeemed digital content for the user's convenience and add such modification to Ota and Antonucci. For example watching content on a television would be nicer than on a cell phone which could be one of the loyalty points redeeming devices, per Antonucci at [0038]). **Such home television set, or alternatively or in addition, a set top box, or a PVR , for example, is considered the claimed CDU which can display selective content based on the AIM and which would store the AIM thereon to avoid accessing the server for redemption as taught by Antonucci.**

Thus **as to claims 1-4, 10, 72-84, 92, 95-97, 106, 107, 108, and 110,** Ota in view of Antonucci and the admitted art as discussed above, disclose:

An advertising control method comprising: receiving an advertisement identification message (AIM) at a first mobile device; secure sending the AIM from the first mobile device to a content display unit (CDU) and storing the AIM in the CDU; selecting at least one content item from among a plurality of content items based, at least in part, on at least one stored AIM, the stored AIM being stored in the CDU; and displaying the selected content item on the CDU; wherein the content item comprises an advertisement or one of the following: music; a music video; an interactive game; and video content.

Claim 10 (dependent on claim 1) :

Since the prior art is silent as to a second user and a second mobile device so the claim,("the selecting is performed without regard to at least one AIM associated with a second mobile device, the second mobile device not being registered on the CDU") reads on the prior art.

8. **Claims 5-7, 8-9, 11-15, 16-23, 99-101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ota et al., US 2002/0035545, Antonucci US 2003/0236704, the admitted art and Official Notices.**

Claims 5-7 (dependent on claim 1):

Ota in view of Antonucci and the admitted art does not disclose but Official Notice (#1) is taken that it is old and well-known at the time of the invention to delete entitlements such as points, coupons once redeemed, to prevent abuse by reuse (see e.g. Aggarwal US 7,013,286, col. 4 lines 40-67, which also discloses the store may check authenticity of the coupon by **verifying the digital signature).**). Similarly marking them as used is old and well-known for the same purpose. Thus it would have been obvious to a PHOSITA to add to Ota et al., above, after the displaying, marking the at least one AIM stored on the CDU as used or deleting the at least one stored AIM from the CDU; or deleting the at least one AIM from the first mobile device.

Claims 8, 11-12 (dependent on claim 1):

Official Notices are taken that the following facts are well-known at the time of the instant invention:

Official Notice #2:

Transfer back and forth of digital data from wireless user devices (e.g. cell phones) to display computing devices is known. Data transfer to non registered devices such as passer-bys is known. (See e.g. "Portable Power by Eric Brown", submitted by IDS, which discloses, near field communications (NFC), i.e. cell phone as contactless smart card. Used for purchases, to put digital images onto TV, billboards etc.. , interactive TV. Eric Brown also discloses data transfer back and forth from billboards to passerby (unregistered) cell phones. Brown also

discloses encryption chips for authenticating online purchases or interactive sessions; use of NFC with STB (page 3).

See also WO 02/46994 disclosing list of ads pushed by STB's (Fig 2) (and display panel) to proximal mobile devices (Fig 3) , which respond by requesting further information from the STB (and display panel) which sends back the further information. Information can be printed out or displayed on display panel or on mobile or sent to more mobile devices. The devices can also be fixed devices.)

Official Notice #3:

Registering or deregistering of cell phones, PDA's and the likes is well known at the time of the invention (see e.g. Ciotti: US 6421731 (col. 14 lines 40-50)

Mobile devices such as telephones, pagers, personal digital assistants (PDAs), data terminals, etc. are designed to be carried throughout the system from cell to cell. ***Each mobile device is capable of communicating with the system backbone via wireless communications between the mobile device and an access point to which the mobile device is registered. As the mobile device roams from one cell to another, the mobile device will typically deregister with the access point of the previous cell and register with the access point associated with the new cell.***

Thus as to claims 8, 11-12, it would have been obvious to a PHOSITA to add to Ota et al above:

registering the first mobile device on the CDU to allow service to the mobile device; sending at least one AIM from the first mobile device registered on the CDU when the mobile device is in the proximity of the CDU since as discussed above ubiquitous computing is to be used for the convenience of the user; and securely sending the AIM from mobile device to the CDU since Ota teaches secure sending of points (citations above).

Claims 13-14:

Official Notice (#4) is taken that it is old and well-known at the time of the invention to query devices and obtain permission before proceeding with a transaction. Thus it would have been obvious to a PHOSITA to add to OTA et al. above, querying a user of the mobile device to authorize sending at least one AIM from the first mobile device to the CDU; and performing the sending only upon receipt of a positive answer to the querying. Since OTA teaches secure sending, the sending performed upon receipt of a positive answer to the querying would obviously include secure sending.

Claim 15: Adding registering the first mobile device on a plurality of CDUs would have been obvious to allow use of the service at different CDUs, e.g. at several TV sets within a home.

Claims 16-18:

Ota et al. does not explicitly disclose the further claim limitations but Official Notice (#5) is taken that public key encryption and authentication schemes are old and well-known at the time of the invention. Thus it would have been obvious to a PHOSITA to add such for secure data transmission.

Claims 19-20:

Ota et al. does not explicitly disclose the further claim limitations of after the receiving, performing a security check on the AIM, including a verifying a digital signature. However Official Notice (#6) is taken that it is old and well-known at the time of the invention that entitlements such as coupons are transmitted using secured means such as digital signature. See e.g. Aggarwal US 7013286 B1 (col. 4 lines 40-67, which discloses the store may check authenticity of the coupon by verifying the digital signature). Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of OTA and add the authentication taught by Aggarwal since the claimed invention is merely a combination of old and known elements and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claims 21-23 (dependent on claims 8, 15, 22):

As discussed above unregistering mobile devices is well-known, see Ciotti above. Also secure registering or deregistering is admitted art. See Spec.[0206]. Thus it would have been obvious to a PHOSITA to add to Ota et al above, unregistering the mobile device from the one or several CDU(s) that it was registered on as it moves around as is well-known in the art (see e.g. Ciotti). Further, using public key authentication is old (Official Notice #5) thus it would have been obvious to a PHOSITA to add public key authentication to the deregistration to ensure data security during the process.

Claim 9 (dependent on claim 1):

Ota et al. does not disclose the selecting is also based, at least in part, on at least one AIM received at the CDU from a second mobile device, the second mobile device not being registered on the CDU. However Official Notice #2 was taken earlier that transfer of data to passerbys, i.e. unregistered devices, from billboards and the likes is well-known. Thus it would have been obvious to a PHOSITA to add allowing an unregisted user to transfer an AIM to the CDU and select content based on such selecting to provide content services to such guests or passerbys as in known in the prior art.

Claims 99-100 (dependent on claim 9): It would have been obvious to a PHOSITA to add to Ota et al in view of Official Notice #2 above:

registering the first mobile device on the CDU to allow service to the 1st mobile device; sending at least one AIM from the first mobile device registered on the CDU when the mobile device is in the proximity of the CDU since as discussed above ubiquitous computing is to be used for the convenience of the user; and securely sending the AIM from mobile device to the CDU since Ota teaches secure sending of points (citations above). It would have been obvious to a PHOSITA to add to instant claim 9 such additional features to accommodate both 1st and 2nd mobile devices.

Claim 101 (dependent on claim 21):

As discussed above unregistering mobile devices is well-known, see Ciotti above. Also secure registering or deregistering is admitted art. See Spec.[0206]. Thus it would have been obvious to a PHOSITA to add to Ota et al above, unregistering the mobile device from the one or several CDU(s) that it was registered on as it moves around as is well-known in the art (see e.g. Ciotti). Further, using public key authentication is old (Official Notice #5) thus it would have been obvious to a PHOSITA to add public key authentication to the deregistration to ensure data security during the process.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lopez 20040143500 discloses processing negotiable economic credits through electronic hand held devices;

Camacho 20090236704, Chien 20010054003 disclose Systems and methods for using loyalty points; Saito 5848158 teaches that in a content distribution system, an authorized user can send encrypted content to an unauthorized user, at which point the unauthorized user can contact a control center to receive authorization and a decryption key for the content (See Saito Col. 5 Line 20 – Col. 6 Line 63); Kaminkow 20030032474 in gaming discloses points to wireless/portable devices and redeemable from a menu of redeemable prizes. The prizes can be

redeemed based on the number of points. Redemption can be done via a video display (see claim 35).

Williams US 7512987 B2 discloses rules based adaptive control of access to digital content from multiple devices, e.g. wandering devices.

Bednarek US 6965868 discloses System and method for promoting commerce, including sales agent assisted commerce, in a networked economy; points to cell phones based on merchants and locations; Bluetooth security.

Fredregill) U.S 5,923,016 discloses a point generation device for carrying out generation and authentication of point data for a portable terminal.

Aggarwal et al U.S. Patent No. 7,013,286 discloses generation, distribution, storage, redemption, validation and clearing of electronic coupons. Authenticity of a **coupon** is verified by its **digital signature**; also verifying if the **coupon** has not been used earlier by contacting a verification center (abstract).

Billboard art:

Kanevsky 7515136 discloses collaborative and situationally aware billboards (Fig 5) invited to games/ register to play/

Art re roaming / registering /deregistering etc..

Williams 7512987 discloses access control to portables/ wandering devices.

Theimer et al. 5555376 discloses method for superimposing pre-specified locational, environmental, and contextual controls on user interactions, including interactions of mobile users, with computational resources; in ubiquitous computing where location and number of devices are important,updating of devices locations by registering , deregistering with location service from one region to next (col 12); encryption while registering.

Watanabe US 7236475 discloses using subnet relations to conserve power in a wireless communication device (claims 25, 32: wireless device deregisters from one network access point, and registers at another during hands-off from 1st to 2nd access points).

McIntosh **20030139180** which discloses hands-off (i.e. deregistering) roaming cellular with decrypt keys (abstract, [0054]-[0055]) to ensure authentication in communication networks.

Kurisko et al US 7174130 B2 discloses Security apparatus and method during BLUETOOTH pairing.

Akiyama US 6463155 (1998) discloses conditional access broadcast system w/ channel keys.

Nakahara US 20030018491 discloses content usage device and network system, and license information acquisition method. Nakahara discloses user devices (including set top boxes

(STB), PDA's etc..) requesting transfer of "license information" (interpreted as equivalent to points or AIMS) from other user devices (STB's , PDA's and the likes), and displaying digital content , including sound data and text content, in accordance with the transferred "license information" ([0392]. Also see abstract, [0050]-[0053], [0061]). It is interpreted the claimed CDU reads on the requesting user device in Nakahara, which can be a home device such as a STB, PDA, home PC and the likes, see [0392]), which at least temporarily stores the AIM to use for displaying the content based on the AIM. Nakahara discloses encryption of data ([0051], [0061], [0127], [0333]); registration of user devices to use the service (e.g. [0075]; [0077]; [0078]; [0245]).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner can normally be reached on Monday-Wednesday 9:00-6:00. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Robert Weinhardt can be reached on 571-272-6633. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314). Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Khanh H. Le/
Examiner, Art Unit 3688
October 13, 2009